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08/964,257	11/04/1997	HITOSHI TERASHIMA	56356	2047

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MCGLEW & TUTTLE, PC  
SCARBOROUGH STATION  
SCARBOROUGH, NY 10510

EXAMINER
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POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 11/05/2003

51

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/964,257

Applicant(s)

TERASHIMA ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-10, 19-25 and 34-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-25, 50 and 52-60 is/are allowed.
- 6) ☒ Claim(s) 7-10, 34-45 and 51 is/are rejected.
- 7) ☒ Claim(s) 46-49 and 61 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 49.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 8/20/03 has been entered.

### *Response to Amendment*

2. Currently, **claims 7-10, 19-25, and 34-61** are pending, whereby each of the claims were previously indicated as allowable.

3. Applicant's amendment, received on 8/20/03, which amends independent **claim 38** alone, has been entered and made of record.

4. The indicated allowability of **claims 7-10, 34-37, and 51** is withdrawn in view of the reference to Shimizu (U.S. Patent Number 5,663,811), which was previously cited in the Office action dated 8/16/00, with respect to claims 52-54 and 56-61. Further, the indicated allowability of **claims 38-45** is withdrawn in view of applicant's amendment, noted above, and the newly discovered reference to Obana *et al.* (U.S. Patent Number 6,247,784). Rejections based on the newly cited reference(s) follow.

***Information Disclosure Statement***

5. The reference listed in the Information Disclosure Statement submitted on 8/20/03 has been considered by the examiner (see attached PTO-1449).

***Drawings***

6. The drawings were received on 5/20/03. These drawings are acceptable by the examiner.

***Claim Objections***

7. **Claims 41, 46-49, and 61** are objected to because of the following informalities:

In **claim 41**, line 8, "said first delivery port" should read "said first sheet delivery port";

in **claim 46**, line 12, "can be rotate" should read "can be rotated" or "can rotate"; and

subsequently, **claims 47-49 and 61** are objected to for being dependent on claim 46.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. **Claims 7-10, 34-37, and 51** are rejected under 35 U.S.C. 102(e) as being anticipated by Shimizu (U.S. Patent Number 5,663,811, cited in the Office action dated 8/16/00).

Regarding *claim* 7, Shimizu discloses an apparatus (see Figs. 2-4) comprising a base apparatus (device body 100) which includes a first sheet transporting path (arrow B, seen in Fig. 4) extending substantially vertically and performs a first processing for a sheet traveling along the first sheet transporting path (column 4, lines 4 through 12), and a scanner apparatus (scanner 200) which can be removably mounted on the base apparatus (see Figs. 2 and 3) and includes a reading element (scanner unit 5, column 3, line 63 through column 4, line 3), wherein a second sheet transporting path (arrow A, seen in Fig. 4) extending substantially vertically is defined by a surface of the scanner apparatus on which the reading element is provided (indicated as scanner unit 5), and a surface of the base apparatus which faces to the scanner apparatus in a case where the scanner apparatus is mounted on the base apparatus (see Fig. 4), and wherein the scanner apparatus (scanner 200) includes a pick roller (drive roller 200b) provided at a location upstream of the second sheet transporting path as viewed in a sheet transporting direction (see Fig. 4, and column 3, line 39 through column 4, line 3) and includes a feed roller (pinch roller 200c) provided at locations downstream of the second sheet transporting path (see Fig. 4, and column 3, line 39 through column 4, line 3), with the first and second sheet transporting paths (arrows A and B) being provided along and adjacent to each other (seen in Fig. 4), and wherein the scanner apparatus (scanner 200) is so implemented as to be capable of operating as a hand scanner in a case where the scanner apparatus is detached from the base apparatus (see Fig. 3, and column 3, lines 53 through 62).

Regarding **claim 8**, Shimizu discloses the apparatus discussed above in claim 7, and further teaches that the scanner apparatus (scanner 200) has a protecting member (being the outer casing of the scanner 200, as seen in Fig. 4), provided in a manner projecting at a side of the surface of the scanner apparatus (see Fig. 4), protecting the pick roller (drive roller 200b) in a case where the scanner apparatus is used as a hand scanner (see Figs. 3 and 4, wherein the casing protects the drive roller 20b, the pinch roller 200c, and the scanner unit 5).

Regarding **claim 9**, Shimizu discloses the apparatus discussed above in claim 8, and further teaches that the protecting member is provided at a location outside of a reading area of the scanner apparatus (see Fig. 4, wherein the reading area is the area contacting the scanner unit 5, and the outer casing of scanner 200 is outside this area).

Regarding **claim 10**, Shimizu discloses the apparatus discussed above in claim 8, and further teaches of an accommodating part accommodating the protecting member is provided in the surface of the base apparatus facing toward the protecting member (seen in Fig. 4, wherein the outer casing of scanner 200 attaches to the device body 100, wherein at the point of contact, the casing of the device body 100 faces the scanner 200, which thereby accommodates the protecting member, being the casing of scanner 200).

Regarding **claim 34**, Shimizu discloses an apparatus (see Figs. 2-4) comprising a base apparatus (device body 100) which includes a first sheet transporting path (arrow B, seen in Fig. 4) extending substantially vertically and performs a first processing for a sheet traveling along the first sheet transporting path (column 4, lines 4 through 12), and a scanner apparatus (scanner 200) which can be removably mounted on the base apparatus (see Figs. 2 and 3) and includes a reading element (scanner unit 5, column 3, line 63 through column 4, line 3), wherein a second

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sheet transporting path (arrow A, seen in Fig. 4) extending substantially vertically is defined by a surface of the scanner apparatus on which the reading element is provided (indicated as scanner unit 5), and a surface of the base apparatus which faces toward the scanner apparatus when the scanner apparatus is mounted on the base apparatus (see Fig. 4), the first and second sheet transporting paths (arrows A and B) being provided along and adjacent to each other (seen in Fig. 4), and wherein the scanner apparatus (scanner 200) may be detached from the base apparatus so as to operate as a hand scanner (see Fig. 3, and column 3, lines 53 through 62).

Regarding *claim 35*, Shimizu discloses the apparatus discussed above in claim 34, and further teaches that the scanner apparatus (scanner 200) includes at least one pick roller (drive roller 200b) provided on a surface where the reading element (scanner unit 5) is provided (see Fig. 4), and a protecting member (being the outer casing of the scanner 200, as seen in Fig. 4) projecting at a side of the surface and protecting the pick roller when the scanner apparatus is used as a hand scanner (see Figs. 3 and 4, wherein the casing protects the drive roller 20b, the pinch roller 200c, and the scanner unit 5).

Regarding *claim 36*, Shimizu discloses the apparatus discussed above in claim 35, and further teaches that the protecting member is provided at a location outside of a reading area of the scanner apparatus (see Fig. 4, wherein the reading area is the area contacting the scanner unit 5, and the outer casing of scanner 200 is outside this area).

Regarding *claim 37*, Shimizu discloses the apparatus discussed above in claim 34, and further teaches that base apparatus (device body 100) includes a first sheet guide (being the roller next to pinch roller 200c, as seen in Fig. 4) provided at a location upstream of the second sheet transporting path (see Fig. 4, following the path of arrow A) and the scanner apparatus (scanner

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200) includes a second sheet guide (pinch roller 200c) provided at a location upstream of the second sheet transporting path (see Fig. 4, following the path of arrow A), and wherein the first and second sheet guides face each other in a manner that a space between the first and second sheet guides gradually narrows toward the second sheet transporting path in a case where the scanner apparatus is mounted on the base apparatus (see Figs. 3 and 4, wherein the space between the two rollers would inherently “narrow” when reattaching the scanner 200 to the device body 100).

Regarding *claim 51*, Shimizu discloses an apparatus (see Figs. 2-4) comprising a base unit (device body 100) including a part of a sheet transporting mechanism (arrow B, seen in Fig. 4, and column 4, lines 4 through 12), a scanner apparatus (scanner 200) which can be removably mounted on the base unit (see Figs. 2 and 3) and includes the other part of the sheet transporting mechanism (arrow A, seen in Fig. 4, and column 3, line 39 through column 4, line 13), and a reading element (scanner unit 5, column 3, line 63 through column 4, line 3), a scanner mounting portion provided on the scanner apparatus and adapted to engage the scanner mounting portion (see Fig. 4), wherein a sheet guide provided on the scanner apparatus (pinch roller 200c) and a sheet guide provided on the base unit (being the roller next to pinch roller 200c, as seen in Fig. 4) are faced each other (see Fig. 4), so that a space defined between the sheet guides becomes gradually narrower toward a sheet withdrawal port (see Figs. 3 and 4, wherein the space between the two rollers would inherently become “narrower” when reattaching the scanner 200 to the device body 100).



10. **Claims 38-45** are rejected under 35 U.S.C. 102(e) as being anticipated by Obana *et al.* (U.S. Patent Number 6,247,784).

Regarding **claim 38**, Obana discloses a multiple function apparatus (see abstract and Figs. 1, 4, and 5) comprising a first transporting guide including a straight guide part (board 4), with the straight guide part being formed so as to transport a first sheet straight and is open at one end (seen in Figs. 1 and 5, column 6, lines 17 through 65), and the deflecting guide part (paper feed roller 2) being connected to the straight guide part at a side opposite the one end (see Fig. 1) so as to transport a first sheet in a direction different from a direction of transport effected by the straight guide part (column 6, lines 25 through 55), a first apparatus (recording head on a cartridge 5) provided at the deflecting guide part (see Fig. 1), and performing processing for the first sheet in a case where the first sheet is transported along the deflecting guide part (column 6, lines 25 through 34, and column 7, lines 22 through 67), a second transporting guide (original loading tray 41), provided along the first transporting guide (see Fig. 1), being formed so as to transport a second sheet (column 6, line 66 through column 7, line 21), a second apparatus (photoelectric conversion sensor 48), provided at the second transporting guide (see Fig. 1), and performing processing for the second sheet in a case where the second sheet is transported along the second transporting guide (column 7, lines 2 through 21), wherein a portion of the second transporting guide which faces to the deflecting guide part is movable (see Fig. 5), so that the first apparatus (cartridge 5) can be exposed (see Figs. 4 and 5, column 9, lines 20 through 57).

Regarding **claim 39**, Obana discloses the apparatus discussed above in claim 38, and further teaches that the second apparatus (photoelectric conversion sensor 48) is provided

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opposite of the first transporting guide (board 4) with respect to the second transporting guide (original loading tray 41, see Fig. 1).

Regarding *claim 40*, Obana discloses the apparatus discussed above in claim 38, and further teaches that a direction of transport of the first sheet effected by the straight guide part (direction following path G) and a direction of transport of the second sheet effected by a portion of the second transporting guide which faces to the straight guide part (direction following path F) form an angle smaller than 90 degrees with the vertical direction in a case where the multiple function apparatus is provided for use (see Fig. 1).

Regarding *claim 41*, Obana discloses the apparatus discussed above in claim 38, and further teaches of a first transporting mechanism (retard roller 3) transporting the first sheet from the straight guide part of the first transporting guide toward the deflecting guide part (column 6, lines 25 through 55), a second transporting mechanism (separating roller 46) transporting the second sheet by the second transporting guide (column 7, lines 2 through 21) in a manner that the second sheet is transported in substantially a same direction as the first sheet (as seen in Fig. 1, directions of paths F and G are substantially a same direction), a first sheet delivery port (discharge roller 6) for delivery of the first sheet from the multiple function apparatus (column 6, lines 30 through 65), the first delivery port being provided at a location downstream of the deflecting guide part (paper feed roller 2) as viewed in a direction of transport of the first sheet (arrow G, see Fig. 1), a second sheet delivery port (roller 49) for delivery of the second sheet from the multiple function apparatus (column 7, lines 4 through 21), the second sheet delivery port being provided at a location downstream of the second transporting guide (separating roller 46) as viewed in a direction of transport of the second sheet (arrow F, see Fig. 1), wherein the

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first and second sheet delivery ports are provided at a same side of the multiple function apparatus (see Figs. 1 and 4).

Regarding *claim 42*, Obana discloses the apparatus discussed above in claim 40, and further teaches that the second transporting guide (original loading tray 41) is provided closer to the front side of the multiple function apparatus than is the first transporting guide (see Figs. 1 and 4), the first apparatus is an image forming apparatus (recording head on a cartridge 5, column 7, line 22 through column 8, line 58), the second apparatus is a scanner (photoelectric conversion sensor 48, column 7, lines 13 through 21), a sheet accommodating part is provided at a location upstream of the first transporting guide as viewed in the sheet transporting direction (feed cassette 1, see Fig. 1), the sheet accommodating part accommodates a plurality of sheets to be fed to the first transporting guide (column 6, lines 25 through 42).

Regarding *claim 43*, Obana discloses the apparatus discussed above in claim 42, and further teaches that a portion of the second transporting guide (original loading tray 41) which faces to the deflecting guide part serves as a part of a cover of the multiple function apparatus and covers the image forming apparatus (see Figs. 1 and 5).

Regarding *claim 44*, Obana discloses the apparatus discussed above in claim 42, and further teaches of a portion of the second transporting guide which faces to the deflecting guide is movable (see Fig. 5), so that the image forming apparatus (recording head on a cartridge 5) can be exposed (see Figs. 4 and 5, column 9, lines 20 through 57).

Regarding *claim 45*, Obana discloses the apparatus discussed above in claim 38, and further teaches that the first apparatus and the second apparatus are provided in such a positional

relation as to overlap each other in the vertical direction in a case where the multiple function apparatus is in use (see Fig. 1).

***Allowable Subject Matter***

11. **Claims 19-25, 50, 52-60** are allowed.
12. **Claims 46-49 and 61** would be allowable if rewritten to overcome the minor informality objected to above.

13. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claim 19**, in the examiner's opinion, it would not have been obvious at the time the invention was made to have the apparatus with the claimed structure having the scanner apparatus removably mounted on the base unit, wherein either the scanner mounting portion of the base unit or the engaging portion of the scanner apparatus is a pivotal shaft for allowing the scanner apparatus to rotate frontwards, while the other holds the pivotal shaft. The closest prior art, previously indicated as Ara *et al.* (U.S. Patent Number 5,889,597) and Shimizu (U.S. Patent Number 5,663,811), both teach of a removable scanner apparatus, but fail to disclose of a with pivotal shaft for allowing the scanner apparatus to rotate frontwards. Because of this, the claim is rendered allowable.

Regarding **claim 24**, in the examiner's opinion, it would not have been obvious at the time the invention was made to have the apparatus with the claimed structure having the scanner apparatus removably mounted on the base unit, wherein a sheet guide is provided in the scanner apparatus and the base unit, and an offset member is provided for at least one of the two sheet guides for stepwise limiting moving of a sheet toward the sheet withdrawal port. The closest

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prior art, previously indicated as Ara *et al.* (U.S. Patent Number 5,889,597) and Shimizu (U.S. Patent Number 5,663,811), both teach of a removable scanner apparatus, but fail to disclose of an offset member is provided for at least one of the two sheet guides for stepwise limiting moving of a sheet toward the sheet withdrawal port. Because of this, the claim is rendered allowable.

Regarding *claim 46*, in the examiner's opinion, it would not have been obvious at the time the invention was made to have the apparatus with the claimed structure having the scanner apparatus removably mounted on the base unit, wherein an engaging portion and a scanner mounting portion hold the scanner apparatus so that the scanner apparatus can be rotated to a direction that the sheet transporting path is open. The closest prior art, previously indicated as Ara *et al.* (U.S. Patent Number 5,889,597) and Shimizu (U.S. Patent Number 5,663,811), both teach of a removable scanner apparatus, but fail to disclose of an engaging portion and a scanner mounting portion hold the scanner apparatus so that the scanner apparatus can be rotated to a direction that the sheet transporting path is open. Because of this, the claim is rendered allowable.

Regarding *claim 52*, in the examiner's opinion, it would not have been obvious at the time the invention was made to have the apparatus with the claimed structure having the scanner apparatus removably mounted on the base apparatus, with a sheet transporting path defined by a reading element of the scanner and a surface of the base apparatus when attached, whereby a cover of the base apparatus guides a sheet from the sheet transporting path, wherein the cover can move so that a device disposed in the base apparatus is exposed. The closest prior art, previously indicated as Ara *et al.* (U.S. Patent Number 5,889,597) and Shimizu (U.S. Patent

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Number 5,663,811), both teach of a removable scanner apparatus, but fail to disclose of a cover of the base apparatus guides a sheet from the sheet transporting path, wherein the cover can move so that a device disposed in the base apparatus is exposed. Because of this, the claim is rendered allowable.

Regarding *claim 59*, in the examiner's opinion, it would not have been obvious at the time the invention was made to have the apparatus with the claimed structure having the image forming apparatus and the scanner apparatus having sheet transporting paths extending substantially vertically, wherein a sheet guide, providing a part of the scanner's sheet transporting path, serves as a cover of a device in the image forming apparatus, and can move such that the device is exposed. Obana *et al.* (U.S. Patent Number 6,247,784) fails to teach if the sheet transporting paths of the image forming apparatus and the scanner apparatus having sheet transporting paths extending substantially vertical. Further, Nakamura (U.S. Patent Number 5,970,217), teaches of the sheet transporting paths extending substantially vertically, but fails to teach of a sheet guide, providing a part of the scanner's sheet transporting path, serving as a cover of a device in the image forming apparatus, and can move such that the device is exposed. Because of these reasons, the claim is rendered allowable.

#### *Citation of Pertinent Prior Art*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Nakamura** (U.S. Patent Number 5,970,217) discloses a facsimile apparatus having trays extending vertically;

**Kanno *et al.*** (U.S. Patent Number 5,893,006) discloses a printing apparatus having a rotatable tray which exposes the image forming device;

**Yamada *et al.*** (U.S. Patent Number 5,559,609) discloses a facsimile apparatus with adjacent feeding paths; and

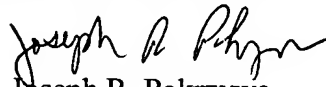
**Ishida** (U.S. Patent number 5,473,352) discloses an image forming device having sheet transporting paths adjacent to each other.

***Conclusion***


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

  
Joseph R. Pokrzywa  
Examiner  
Art Unit 2622

jrj

  
EDWARD COLES  
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